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*In re* Application of:

MICHELSON, GARY K.

Serial No.: 08/354,450

Filed: Dec. 12, 1994

Docket: P10936V

Title: DEVICE FOR ARTHROSCOPIC  
MENISCAL REPAIR

JUN 04 2007  
DECISION ON PETITION FOR  
CORRECTED EXAMINER'S  
ANSWER

This is a decision on the petition filed on Sept. 1, 2005 to request to send a correct Examiner's Answer.

The petition is **DISMISSED**.

In the petition, petitioner requests the examiner to correct the Examiner's Answer of July 1, 2005 with clear designation of three new grounds of rejection. In support of the petition, petitioner alleges that the examiner entered three new grounds of rejection in the Examiner Answer of July 1, 2005. They are: (1) the rejection of independent claim 144 under 35 U.S.C. § 112, first paragraph, as not being supported in the specification as originally filed relative to the phrase "at least a portion of said bottom forming an included angle relative to the mid-longitudinal axis of said shaft that is greater than 90 degrees;" (2) the rejection of claim 192 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,261,914 to Warren ("Warren") in view of U.S. Patent No. 4,548,202 to Duncan ("Duncan"); and (3) the objection to the specification as not meeting the enablement requirement of 35 U.S.C. § 112, first paragraph.

The record shows that:

- 1) In response to a non-final Office action, on Jan. 7, 2004 the applicant submitted an amendment with many changes in the specification and substituted for claims 1-28 with new claims 29-300.
- 2) On March 19, 2004, the examiner issued a final Office action rejecting claims 29-300 under first paragraph and second paragraph of 35 USC 112 for lack of support for the invention as claimed and 35 USC 103 as obvious over the prior art references.
- 3) In response, on Sept. 20, 2004, the applicant filed amendment after final and made a few minor changes to dependent claims 40, 41, 72, 73, 114, 115, 156, 173, 191, 208, 222, 239, 253 and 270. The applicant also presented arguments to traverse all rejections and objections as stated in the final Office action.

- 4) In the Advisory Action of 11/4/04, the examiner entered the amendment after final for appeal purposes.
- 5) On April 20, 2005, the applicant filed an Appeal Brief appealing all rejected claims 29-300.
- 6) On July 1, 2005, the examiner issued an Examiner's Answer.
- 7) The applicant on Sept. 1, 2005 filed a Reply Brief to the Examiner's Answer of July 1, 2005. In his Reply Brief, the applicant argued, *inter alia*, that the examiner improperly raised three new grounds of rejection in the Examiner Answer of July 1, 2005 without any designation or notation as new grounds of rejection. The applicant further rebutted the alleged three new grounds of rejection.
- 8) On Sept. 1, 2005, the applicant also filed the current petition requesting that the examiner to issue a corrected Examiner's Answer with designation of the three new grounds rejection.
- 9) In response to the Reply Brief of Sept. 1, 2005, the examiner issued a Supplemental Examiner's Answer on Dec. 1, 2005 and explained his position regarding three new grounds of rejection.
- 10) On Feb. 1, 2006, the applicant filed another Supplemental Reply Brief, *inter alia*, further rebutted all three grounds of the new rejection.
- 11) On May 22, 2006, the Board of Patent Appeals and Interferences issued an Order Returning Undocketed Appeal To Examiner for consideration of two pending petitions filed April 24, 2003 and Sept. 1, 2005 and request of TC Director's authorization in the Supplemental Examiner's Answer of Dec. 1, 2005.
- 12) On June 21, 2006, the examiner mailed a Supplemental Examiner's Answer with TC Director's signed acknowledgement and authorization to satisfy one of the three requirements as stated in the Order.
- 13) On Aug. 4, 2006, the applicant submitted a Second Supplemental Reply Brief indicating the Supplemental Examiner's Answer with TC Director's authorization mailed on June 21, 2006 is a duplicate of the first Supplemental Examiner's Answer.

#### Relief Requested

In the petition, petitioner requests a corrected Examiner's Answer be sent designating: (1) the rejection of independent claim 144 under 35 U.S.C. § 112, first paragraph, as not being supported in the specification as originally filed relative to the phrase "at least a portion of said bottom forming an included angle relative to the mid-longitudinal axis of said shaft that is greater than 90 degrees;" (2) the rejection of claim 192 under 35 U.S.C. § 103(a) over Warren in view of Duncan; and (3) the objection to the specification as not meeting the enablement requirement of 35 U.S.C. § 112, first paragraph, as new grounds of rejection.

#### Analysis and Discussion

In order to determine whether or not the Examiner's Answer of July 1, 2005 contains any new grounds of rejection, a comparison and analysis of the final Office action of March 19, 2004 and the Examiner's Answer must be made. The focus must be placed on pages 2-6 of the rejection of claims 144 and 192 and the objection to the specification under 35 USC 112, first Paragraph in

the Final Rejection mailed on March 19, 2004 and pages 2-10 of the rejection of claims 144 and 192 and the non-art rejection/objection of the Examiner's Answer mailed on Jul 1, 2005.

On page 4 of the petition, petitioner argues that the examiner's rejection under 35 U.S.C. § 112, first paragraph, of the phrase "at least a portion of said bottom forming an included angle relative to the mid-longitudinal axis of said shaft that is greater than 90 degrees" as recited in independent claim 144 constitutes a new ground of rejection. The phrase was not previously rejected by the examiner in the March 2004 Office Action.

The rejection of claim 144 is based under 35 U.S.C. § 112, first paragraph, in the final Office action of March 19, 2000 because of new matter for claiming the included angle is greater than 90°. However, as found in the final rejection of March 19, 2004 and in the Examiner's Answer of Jul. 1, 2005, the specification is objected to as containing new matter which was pointed out in Item g) in the examiner's answer and item L) in the final rejection. The examiner stated that claiming the included angle as obtuse e.g. >90° is new matter and that all of the claims 29-300 are rejected as containing at least one of the many limitations containing new matter or is dependent on claims containing new matter. Therefore, there is no new ground of rejection in the Examiner's Answer that was not stated in the final Office action.

At the bottom of page 4 to top of page 5 of the petition, petitioner argues that in the Examiner's Answer, the examiner replied to Appellant's remarks that Warren did not teach or suggest the subject matter of claim 192 by incorporating for the first time the teachings of Duncan into the rejection that was previously over Warren alone. (See Examiner's Answer, page 20, paragraph 3). Petitioner contends that the examiner failed to provide any rationale specific to claim 192 for the 35 USC 103 rejection based on Warren alone. Examiner's combination of Duncan with Warren to reject claim 192 also constitutes a new ground of rejection.

A review of the final Office action and the Examiner's Answer, it appears that claim 192 was rejected twice. Claim 192 was rejected under 35 USC 103 as unpatentable over Warren alone and again rejected under 35 USC 103 as unpatentable over Warren in view of Duncan or Chisholm or Parvenu. Petitioner's argument regarding claim 192 is not persuasive because there are no changes between the final Office action and the Examiner's Answer regarding the rejections of claim 192. Therefore, the rejections of claim 192 in the Examiner's Answer cannot be considered a new ground of rejection.

With regard to the arguments that the examiner failed to provide any rationale for rejecting claim 192 under Warren reference alone, this is an appealable matter<sup>1</sup>. This decision will not address any deficiencies or propriety of the rejection because they are appealable issues and will be addressed by the Board of Appeals and Interferences in due course.

On page 5 of the petition, petitioner argues that the March 19, 2004 final Office Action did not contain an objection to the specification as not meeting the enablement requirement of 35 U.S.C. § 112, first paragraph. In support to this argument, the petitioner argues that in the examiner's

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<sup>1</sup> 37 CFR 1.181(a)(1) states: Petition may be taken to the Director: From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination preceding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

response to the appellant's arguments, the examiner used the language out of Form Paragraph 7.31.02, which is directed to "enablement" issue. Accordingly, the objection to the specification as not meeting the enablement requirement of 35 U.S.C. § 112, first paragraph, constitutes a third new ground of rejection.

This argument is not persuasive because the objection to the specification is not enabling under 35 USC 112 first paragraph. There is no rejection under 35 USC 112 first paragraph concerning enablement in the final Office action or in the Examiner's Answer. However, there was objection to the specification and rejection of claims 29-300 under 35 USC 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed. There appears to be no support in the specification for the above noted claim language or the criticality why this is now being claimed. Claims 29-300 were rejected, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This objection to the specification and rejection of claims 29-300 are clearly in compliance with MPEP 2163.06<sup>2</sup>. In view of the totality of the final Office action and the Examiner's Answer, the Form paragraph 7.31.02 the Petitioner referred to appears to be a mistake and irrelevant to the objection to the specification and rejection of claims 29-300 under 35 USC 112, first paragraph concerning written description because the issues remain the same. The issues are whether or not the original filed specification (a) provides adequate support for the claim language or the criticality of the claim subject matter and (b) describes the claim subject matter in such a way as to reasonably convey to one skilled in the relevant art. Therefore, the form paragraph petitioner referred to becomes irrelevant to the issues before the Board. The comparison of the final Office action and the Examiner's Answer shows that there is no new ground of rejection in the Examiner's Answer that was not stated in the final Office action.

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<sup>2</sup> MPEP 2163.06 Relationship of Written Description Requirement to New Matter Lack of written description is an issue that generally arises with respect to the subject matter of a claim. If an applicant amends or attempts to amend the abstract, specification or drawings of an application, an issue of new matter will arise if the content of the amendment is not described in the application as filed. Stated another way, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter. There are two statutory provisions that prohibit the introduction of new matter: 35 U.S.C. 132 - No amendment shall introduce new matter into the disclosure of the invention; and, similarly providing for a reissue application, 35 U.S.C. 251 - No new matter shall be introduced into the application for reissue.

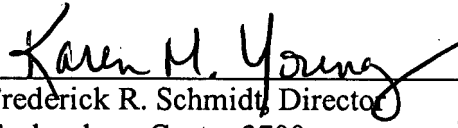
I. TREATMENT OF NEW MATTER If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings, the examiner should object to the introduction of new matter under 35 U.S.C. 132 or 251 as appropriate, and require applicant to cancel the new matter. If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). The examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant. In an instance in which the claims have not been amended, per se, but the specification has been amended to add new matter, a rejection of the claims under 35 U.S.C. 112, first paragraph should be made whenever any of the claim limitations are affected by the added material. When an amendment is filed in reply to an objection or rejection based on 35 U.S.C. 112, first paragraph, a study of the entire application is often necessary to determine whether or not "new matter" is involved. Applicant should therefore specifically point out the support for any amendments made to the disclosure.

Conclusion

For the foregoing reasons, the relief requested by petitioner cannot be granted. In particular, there was no new ground of rejection found in the Examiner's Answer of July 1, 2005. The petition is dismissed.

The application is being returned to the Board of Appeals and Interference for decision. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

PETITION DISMISSED

for   
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Frederick R. Schmidt, Director  
Technology Center 3700